

Attachment H



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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/720,821 | 11/24/2003 | Douglas B. Wilson | 114089.120 | 5355 |
| 23483 | 7590 | 05/27/2010 | | |
| WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109 | | | EXAMINER LUONG, VINH | |
| | | | ART UNIT 3656 | PAPER NUMBER |
| | | | NOTIFICATION DATE 05/27/2010 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|---|-----------------|--------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) | |
| | 10/720,821 | WILSON, DOUGLAS B. | |
| | Examiner | Art Unit | |
| | Vinh T. Luong | 3656 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 20 May 2010. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 20-29.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See attached sheets.

/Vinh T Luong/
Primary Examiner, Art Unit 3656

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13. **REQUEST FOR RECONSIDERATION/OTHER**

In response to Applicant's remarks, the Examiner respectfully submits, *inter alia*, the following.

Shigeru

It is well settled that the claims drawn to an apparatus must distinguish from prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997); *In re Danly*, 120 USPQ 528 (CCPA 1959); *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987); and MPEP § 2114. The Court in *Schreiber* has laid Applicant's arguments to rest by pointing out that: "[a]lthough *Schreiber* is correct that Harz does not address the use of the disclosed structure to dispense popcorn, *the absence of a disclosure relating to function does not defeat the Board's finding of anticipation.*" In fact, the Court in *Schreiber* emphasized:

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("*[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.*"). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

See also *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); *In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

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In addition, as noted, an anticipatory reference needs not duplicate word for word what is in the claims. Anticipation can occur when a claimed limitation is “inherent” or otherwise *implicit* in the relevant reference. *Standard Haven Products Inc. v. Gencor Industries, Inc.*, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). Further, it is well settled that an anticipatory reference needs not provide such explanation to anticipate what artisan would know as evidenced by standard textbook. *In re Opprecht*, 12 USPQ2d 1235 (Fed. Cir. 1989).

In the instant case, Shigeru’s second section is made of flexible material similarly to Applicant’s second section (Translation, pp. 1 and 4 of the translation). Thus, Shigeru’s second section is capable of deforming/flexing out of interference with the vehicular operator's ability to operate the steering wheel 2 when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel 2 in the same manner as Applicant’s second section due to their structural similarity. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986) and *In re Schreiber, supra*.

In view of the foregoing, the Examiner respectfully declines Applicant's request to withdraw the rejection based on Shigeru.

Van Arsdel

The rejection based on Van Arsdel was withdrawn in the last final rejection on May 13, 2010. Therefore, Applicant’s arguments about Van Arsdel are deemed to be moot.

Obviousness-type Double Patenting Rejection

The Examiner respectfully submits that the terminal disclaimer filed in copending Application 10727306 is not effective to overcome the obviousness-type double patenting

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rejection made in this application for the reasons set forth in the final rejection on May 13, 2010 and the telephone interview on May 17, 2010 (see Examiner's Interview Summary mailed on May 21, 2010). Thus, this ground of rejection is respectfully maintained.